

REMARKS

Claims 1-21, 30, and 31 are pending in this application. In addition to the claim changes and remarks presented in the Amendment filed April 25, 2005, for which Applicants have requested entry and consideration, Claim 31 has been amended herein.

As an initial matter, Applicants acknowledge with appreciation the Examiner's indication in the Advisory Action of May 10, 2005 that the changes to Claim 30 presented in the Amendment of April 25, 2005 would overcome the rejections under 35 U.S.C. §112, first and second paragraphs.

The Examiner stated in the Advisory Action that Claim 31 would remain rejected under 35 U.S.C. §112, first and second paragraphs. Applicants respectfully request reconsideration and withdrawal of these rejections for the following reasons.

The specification discloses that certain portions of a tire tread exhibit a "phenomenon of sliding," while other portions of the tread are "possibly sliding parts" that are "too small to provide an exploitable measurement." (Paragraph 69, emphasis added). From this description, it can be seen that certain portions of the tire tread, i.e., the "possibly sliding parts," slide "substantially less" than other portions, i.e., those that exhibit the "phenomenon of sliding." Thus, it is believed that Claim 31, prior to amendment herein, met the requirements of 35 U.S.C. § 112.

Nevertheless, Claim 31 has been amended herein to recite that the second tread element, at least within a range of rolling conditions to be monitored, slides insufficiently to allow measurement of a tangential force. It is believed that this claim

feature is fully supported by the specification and that the metes and bound of this claim feature would be readily understood by one of ordinary skill in the art.

With respect to the rejections under 35 U.S.C. §§ 102 and 103, Applicants refer the Examiner to the Amendment of April 25, 2005, along with the following additional comments regarding the rejections of Claims 7-17 over Brazil 200002924 (“Brazil”) in view of JP 61-263807, JP 6-171321 or JP 8-118918 (“the Japanese references”).

It is well-established that “[t]he prior art can be modified or combined to reject claims as prima facie obvious as long as there is a reasonable expectation of success. MPEP 2143.02 (citing *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986)). Moreover, “[t]he teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant’s disclosure.” M.P.E.P. § 2143 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)).

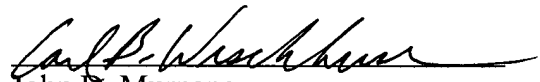
The Examiner asserts in the Advisory Action that one of ordinary skill in the art would have been motivated to combine Brazil with the Japanese references “so as to provide means for measuring stresses.” (Advisory Action at page 4). However, it is respectfully submitted that this extremely general rationale provides absolutely no basis for a reasonable expectation of success. This is particularly evident when one considers that the cited Japanese references have nothing to do with making measurements. Rather, these references are concerned with improving tire wear characteristics or traction (see abstracts). Brazil, on the other hand, is concerned with making measurements using a “sacrificed rib” (see abstract).

Applicants respectfully request that the Examiner provide a specific explanation of why one of ordinary skill in the art would have expected success in combining Brazil with the Japanese references, assuming *arguendo* that there would have been motivation for such a combination. Otherwise, Applicants respectfully request withdrawal of these rejections.

In view of the foregoing amendments and remarks, favorable reconsideration and allowance of all pending claims is earnestly solicited.

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,



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